REMARKS

The Office Action mailed April 6, 2007 ("Office Action") rejects claims 26-31 and 50-76 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,809,145 to Slik *et al.* ("Slik") in view of U.S. Patent No. 5,809,145 to Grundy ("Grundy") or U.S. Patent No. 5,490,216 to Richardson. Applicants respectfully traverse the rejections as follows.

I. Introduction

The invention, as claimed, concerns a system and method for the manufacture of digital information products comprising physical media on demand at a local site, such as a retail outlet, and this entails providing at the designated site a local mass data store for the digital information for a plurality of different products, a local media generator for producing a selected product by storing the relevant digital information on a blank physical media, and a packaging generator for supplying packaging for the selected product for supply to the customer. The invention as claimed allows the entire process of selecting and producing a single item of physical media representing an individual information product to take place locally at the designated site, which in practice may be a point of sale unit in a retail store, by way of example.

The process according to the invention as claimed is thus a very different process from the conventional distribution arrangement by which the full range of titles in stock in a retail store are stored as physical end products from the outset and prior to any selection, purchase, or request for purchase by the customer. It is also a very different arrangement from a system enabling an individual at their home PC to scan, select and download titles over the Internet onto their PC. The idea of manufacturing on demand at a local outlet only those titles that have actually been selected for purchase is an entirely different and novel concept.

Descriptions of certain embodiments of the present invention may be found on the assignee's website, described there under the name Softwide. The Examiner is invited to peruse these web sites for an understanding of how certain embodiments may appear in practice:

http://www.tribeka.com/websitepages/tech.html

http://www.tribeka.com/websitepages/comp.html

http://www.tribeka.com/websitepages/benefits.html

II. The Cited Art Fails To Disclose Local Product Generation Including A Unique Release Code

Claim 1 recites "a local media generator arranged to generate the selected product by storing on the physical media said digital information and by recording on the physical media the issued [unique] release code." Claim 50 recites "generating the selected product at the point of sale by storing on the physical media said digital information and by recording on the physical media the issued [unique] release code." The cited references, alone or in combination, fail to disclose these limitations.

Slik concerns a conventional electronic distribution arrangement in which an individual end user simply downloads information from the Internet onto their home PC. According to Slik, a user at their personal computer 12 can browse and search data, supplied by a remote information provider 11, via a communication network 22 and a server 24, a relational database server 28, a website server 30 or the Internet 32. Having selected a dataset, the individual user at home can then download it directly to the hard drive 15 of their computer 12 in encrypted form, and obtain upon appropriate payment a release code from a fulfillment centre 14 for decryption purposes.

Consequently, Slik fails to consider local manufacture of a physical end product. Further, Slik fails to consider storage of a unique release code on an item of physical media that has just been produced, *e.g.*, for audit and tracking purposes. The present invention differs from the disclosure of Slik not only in the use of explicit customer selected information but also in the local manufacture of a specific physical end product, comprising an item of physical media storing a selected information product, and in the application to such physical end product of a unique release code for security and tracking purposes.

Grundy concerns the licensing of a product, such as software on a storage disc, following manufacture and supply to ensure that the use of the software is appropriately authorized and controlled. According to Grundy, a product 14 on a disc 13, which has already been manufactured and supplied to an individual user, is loaded onto the memory 11 of the individual user's processor 10, and the user's processor 10 accesses a central database 112 by way of modems 18, 19 in order to determine the authorized level of access. To obtain full access, the

user executes a registration process involving a registration code and payment of a fee. There is no local manufacture of a physical end product, because the disc 13 has already been manufactured and previously purchased by the user.

Richardson, like Grundy, discloses a system for registering software for use after a magnetic disc 10 bearing the software has already been manufactured and supplied. The disc 10 includes a registration routine which is arranged to execute on the first occasion that the disc is used. The prospective new user 11 inserts the disc 10 into their home PC 12, and the registration routine is thereby activated to cause a series of dialogue boxes to appear on the display of the PC 12. Thus, Richardson at most discloses allowing access to previously-purchased software, and no local manufacture takes place.

The use of a unique release code as claimed offers many advantages over the cited art. The invention as claimed has the potential to track counterfeits, which none of the cited patents offer. This security feature is achieved by issuing a respective unique release code for each individual item (physical media) and by integrating the unique release code on the physical media at the time when the selected product is generated by recording the associated digital information on the physical media. This feature results in a wholly unique item on each occasion that the physical media are produced, since although the selected title may be general, the release code is unique. This feature further provides a mechanism to audit the process and to track post sale and even allow for returns. The cited art wholly fails to teach or suggest "recording on the physical media the issued [unique] release code" as claimed.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: "[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations." Because the cited references fail to disclose "a local media generator arranged to generate the selected product by storing on the physical media said digital information and by recording on the physical media the issued release code" or "generating the selected product at the point of sale by storing on the physical media said digital information and by recording on the physical media the issued release code," the rejection is improper. Applicant accordingly

respectfully requests that the rejection of claims 1, 50 and all claims dependent thereon be withdrawn.

III. The Cited Art Fails To Disclose Manufacturing In Response To A Release Code

Claim 1 recites "a local control unit responsive to said unique release code from said remote control centre to sanction and control physical production of said selected product." Claim 50 recites "sanctioning and controlling physical production of said selected product in response to said obtained unique release code." The cited references, alone or in combination, fail to disclose these limitations.

As presently claimed, manufacturing on demand only takes place upon issuance of a unique release code. It is important to note that the unique release code is not a licence authorizing use of the information product, *i.e.*, of the data on the physical media, as in the prior art, but rather an authorization actually to manufacture the product. This is another novel aspect of the invention, which thus provides means by which the novel concept of manufacture on demand may be securely achieved without abuse and with the facility for auditing the manufacturing process, tracking physical media post-sale, and locating counterfeits.

As discussed above, Slik, by contrast, concerns a conventional electronic distribution arrangement in which an individual end user simply downloads information from the Internet onto their home PC. Consequently, Silk's code authorizes use of the dataset and not manufacture of any product. Silk entirely fails to disclose or suggest "sanctioning and controlling physical production of said selected product in response to said obtained unique release code."

Grundy concerns the licensing of a product, such as software on a storage disc, following manufacture and supply to ensure that the use of the software is appropriately authorized and controlled. Grundy's registration process serves for accessing the information or product after manufacture of the disc 13 rather than for actual release of the product for the purposes of manufacture. No release code is embedded on the disc 13 and therefore every such disc bearing the information or product 14 will be identical.

By contrast, the release code in the present invention is primarily for the purposes of authorizing manufacture of the physical end product, and each physical item is unique even for the same information product because each release code is unique and is recorded on the physical media. Accordingly, it can be seen that in the present invention the release code is for authorization of manufacture, and then for audit and tracking of the physical media, and not simply for accessing data as Grundy discloses.

Richardson, as discussed above, discloses a system for registering software for use after a magnetic disc 10 bearing the software has already been manufactured and supplied. Richardson fails to disclose the use of a release code for the purposes of authorizing manufacture of a single item of physical media. Furthermore, each individual disc 10 as manufactured and supplied by Richardson will be identical. The present claims, by contrast, are directed to an entirely unique physical end product (*e.g.*, disc) incorporating a unique release code, which is produced on each occasion that any selected product is requested and a physical media is generated.

Accordingly, all of the cited art effectively address the same problem, namely the licensing or registration for use of identical copies of a product after manufacture, distribution and sale have already taken place and all of them offer very similar solutions. The function of the licence in each case is to "release" or make available for use the software that the individual has previously purchased and received, and for this purpose the licence may be embedded directly onto the host PC of the user. Thus, the licence arrangement according to the prior art is only for authorizing use following sale. By contrast, in the present invention, the licence provides a mechanism to authorise the manufacture of the physical media including the selected information product. The manufacturing process is fully automated and occurs responsive to issue of a release code.

Under 35 U.S.C. § 103, all claim limitations must be taught or suggested in the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). MPEP § 2143 reinforces this principle: "[T]he prior art reference (or references when combined) must teach or suggest all the claim limitations." Because the cited references fail to disclose "a local control unit responsive to said unique release code from said remote control centre to sanction and control physical production of said selected product" or "sanctioning and controlling physical production of said selected

product in response to said obtained unique release code," the rejection is improper. Applicant accordingly respectfully requests that the rejection of claims 1, 50 and all claims dependent thereon be withdrawn.

IV. Conclusion

In view of the above, Applicants respectfully request that the rejection of the claims specifically argued, as well as all claims dependent thereon, be withdrawn. Applicant respectfully submit that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

Applicants submit the present response together with a petition for a two-month extension of time and associated fee. In the event that the U.S. Patent and Trademark Office requires an additional fee to enter this Reply or to maintain the present application pending, please charge such fee to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

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Dated: October 29, 2007

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